

REMARKS

I. Prosecution History

The application was originally filed with 39 claims numbered 1-38 because two duplicate claims were erroneously submitted. In the first office action dated September 22, 2004, the Examiner rejected claims 1-39. The Examiner also recognized a discrepancy in claim numbering and objected to claims 3 as redundant to claim 2. The Examiner requested that all claims in the application be renumbered. Applications responded to the first office action with a response and an amendment in which original claims 1, 2, 3, 4, 6, 7, 8, 10, 11, 12, 13, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, and 37 were amended to correct numbering, claim 38 remained in original form, and new claims 39-56 were added. In a second, FINAL office action the Examiner rejected claims 1-56. Claims 3, 39, 42, 46 and 51 were amended in response to the final action. In an Advisory Action, the amendments to claims 3, 39, 42, 46 and 51 were entered, but claims 1-56 remained rejected. The final rejection of claims 1-56 was appealed.

Following a decision by the Board of Appeals and Interferences, Applicants now file a Request for Continued Examination and provide this paper as a submission therewith. Independent claims 1, 18, 19, 20, 35, 41 and 45, and several underlying dependent claims have been amended with this submission. Claims 1, 3-20, 35, 36, 41 and 45-49 remain pending.

II. Discussion

On appeal, the Board of Patent Appeals mostly adopted the arguments of the Patent Examiner. The Examiner's primary rejections are based on 35 U.S.C. § 103. The Examiner relies, primarily, on two references; the first being Anderson et al. (US Patent No.: 6,578,203 B1), and the second being Jain et al. (US Patent No.: 5,729,471). On appeal, the Examiner argued Anderson teaches a system and method for providing venue-based data, including processing the video images for

wireless transmission to more than one handheld device. The Examiner further argued Jain teaches a system and method for providing a display for simultaneous viewing of more than one perspective of a venue-based event captured by more than one video camera.

The Applicant's primary argument against the 35 U.S.C. §103 rejection are based on the contention that neither Anderson nor Jain disclose, teach or suggest a handheld device as described in the present invention.

In order to assess the soundness of a conclusion that *Anderson et al* and *Jain* in combination teach a wireless handheld device allowing multiple perspective views, it is first necessary to establish as true, that the Anderson reference actually teaches a handheld device, and Jain actually teaches a device allowing for multiple perspectives, and then decide if one of ordinary skill would find it obvious to combine them.

What is distinct about the *Anderson et al* reference has been pointed out several times throughout the prosecution history and on appeal. *Anderson et al* is not operated as a "hand held device" as defined by applicant's specification, and the device described in the *Anderson et al* reference is specifically referred to and taught as being a "head mounted display." The *Anderson et al* reference is in fact entitled "audio/video signal distribution system for Head Mounted displays."

FIG. 4 copied from *Anderson et al* shows the device 104 as being a "Head Mounted Display."

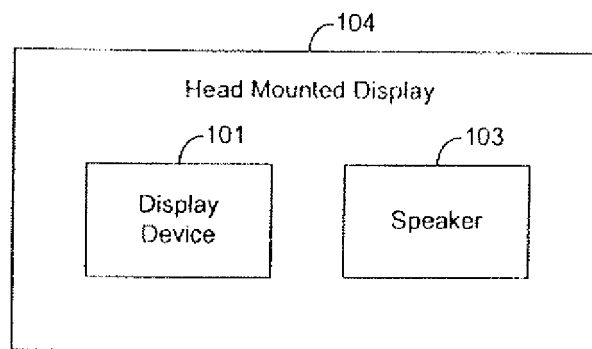


FIG. 4

Unlike *Anderson et al* Applicants did not on appeal, and do not now, teach or claim a head mounted display. *Anderson et al* requires the user to mount a binocular-like device up to the user's eyes in order to view a video presentation. *Anderson et al* describes the head mounted display "HMD" 104 by referring to another well known "head mounted" device from the prior art. *Anderson et al* reference calls on support for a HMD into his specification by referring to U.S. Patent No. 5,844,656 entitled "Head Mounted Display with Adjustment Components" by *Ronzani et al*, which is specifically incorporated by reference in *Anderson et al* (i.e., see column 25, lines 25-30).

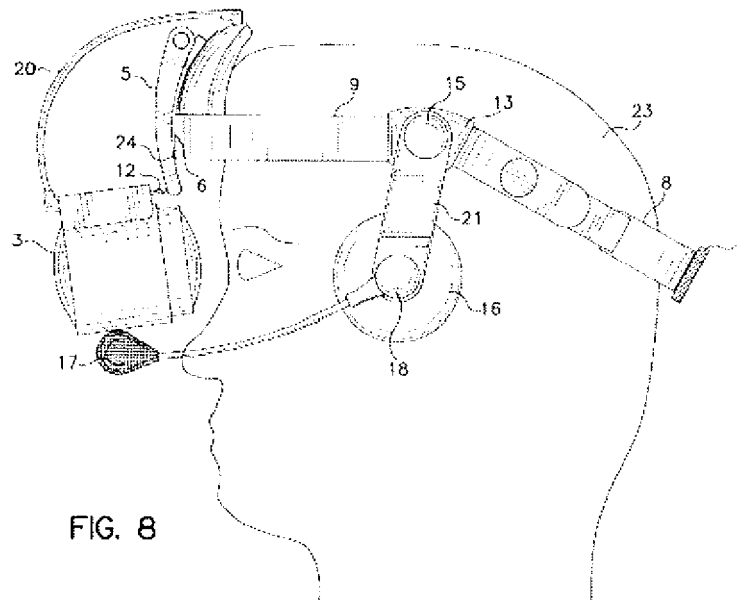
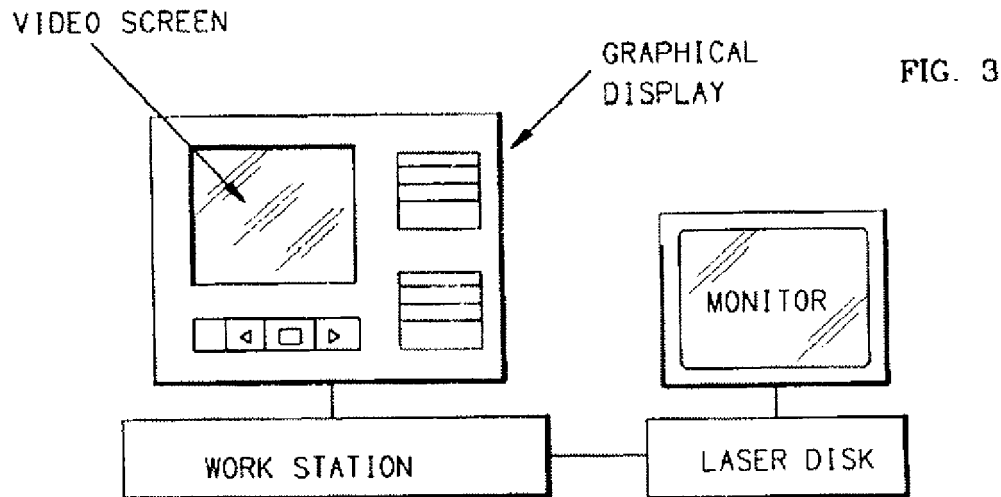


FIG. 8

Jain et al describes the use of physically wired computer workstations to simultaneously view and edit video from more than one displayed video perspective at a time. As shown below in FIG. 3 copied from the *Jain et al* reference, workstations are intended for use on a desktop or workbench, would be connected by wires to power and a network, and by their very nature are not capable of being hand held and would not be useful to attendees at a live entertainment venue.



The *Jain et al* limitations are most apparent by observing Figures 3, 4 and 12 and reading the supporting text in the *Jain et al* specification. *Jain et al* does not hint or suggest at the use of workstations as hand held devices by users at an entertainment venue. Such use would clearly be impossible given a workstation's physical wiring and power requirements, and unbearable to a user given a workstation's weight and size.

Applicants' still maintain that one of ordinary skill in the art would not be combine *Jain et al* with *Anderson et al* to arrive at a Applicants' invention as now claimed. Furthermore, one skilled in the art would not be motivated to combine *Anderson* with *Jain*, and also *Blanchard* or *Ausems* to arrive at the invention now newly claimed by Applicants. *Ausems et al* and *Blanchard* does not discuss video functionality. For one to be motivated to combine reference from such diverse field of use require more than ordinary skill or common sense.

The Bulk of the case law regarding obviousness rejections is based on explaining the analysis used to evaluate a combination of references. In the present case, the question is only whether a specific limitation of the present invention is singularly taught or suggested by the *Anderson* reference. This means most of the discussion regarding the application of the *Graham* factors or the interpretation from *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (U.S. 2007) is irrelevant.

Under the Holding in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684, 148 U.S.P.Q. 459 (1966), the supreme court established a three part factual inquiry to determine the obviousness of an invention. This includes a determination of the scope and content of the prior art, a determination of the differences between the claimed invention and prior art, and a determination of the level of ordinary skill in the art. Once these issues are resolved, the Examiner is compelled to determine if the invention is obvious. Under the holding in *KSR International Co.* the Examiner must offer explicit analysis explaining the rationale for the rejection.

It is important to note the Examiner's Final Rejection and the Board of Patent Appeals and Interferences decision on Appeal both fail to offer the explicit analysis explaining the rationale for the rejection as required under the holding in *KSR International Co.* Although the final rejection of the Application was issued before the decision in *KSR International Co.*, the Decision on Appeal was issued after the *KSR International Co.* decision. As such, the current rejection has failed to offer the requisite explanation of the rationale for the rejection.

On Appeal, the Board primarily relied on the Examiner's interpretation of the Applicant's definition of handheld devices and the rule from *Am. Acad. Of Sci Tech.*, requiring claims be given their broadest reasonable interpretation consistent with the specification to find Anderson teaches a handheld device. While it is the case that claims are to be given their broadest reasonable interpretation, this also suggests there is some limit as to how broadly they may be interpreted. First, the Examiner is required to give the claims their broadest reasonable interpretation, in view of the specification. In this case, the specification clearly delineates the types of devices that are considered handheld devices. It is clear that a head mounted display unit is not among these devices. In addition, in *In re Thrift*, 298 F.3d 1357, the court explains the phrase in question should be interpreted consistently with its plain meaning.

The plain meaning of "hand held" is that a device is primarily designed to be used and operated while in a person's hand. Further, the plain meaning of "head mounted" is for a device to primarily function while mounted on a person's head.

As such under the standard in *Thrift* the court has given both the reference and the present claims an unreasonably broad interpretation.

According to *Acad. of Sci. Tech. Cir.*, 367 F.3d 1359 (Fed. Cir. 2004); *Morris*, 127 F.3d 1048 (Fed. Cir. 1997) the claim language should be interpreted in accordance with the reading given by one skilled in the appropriate art. The Board recognized the definition of "hand held device" provided in the specification and the limitations of record over *Anderson et al*, yet the Board still decided that the *Anderson et al* reference taught a handheld device. The Board's finding of fact 4 was that *Anderson et al* taught head mounted displays or any other portable devices, citing col. 5, lines 22-37, and col. 6, lines 7-13. The Board suggested the *Anderson et al* device can be touched by the hands and is therefore handheld. While this reference does state the "transceiver is portable", the *Anderson et al* material also explains that the transceiver is a head mounted display. The issue of whether the device is portable is not at issue. Rather, the question is whether the unit is handheld. Thus, the description of the device as head mounted is clear and unambiguous evidence that it is an unreasonably broad interpretation of the *Anderson* reference to suggest it teaches a handheld device.

As noted above, the Examiner's rejection was based on the premise that the *Anderson et al* reference teaches or suggests a handheld device. However, it is commonly accepted that it is improper to change the basic principle under which the primary reference was intended to operate. *Application of Ratti*, 46 C.C.P.A. 976, 270 F.2d 810, 123 U.S.P.Q.349 (1959). This speaks to the heart of the error of accepting the *Anderson et al* reference as a teaching or suggestion of a handheld device.

First, in a broad sense, a handheld device and a head mounted device are different. The basic principle of operation for the head mounted device described in *Anderson et al* is to avoid "the handling of multiple radios [which] is generally cumbersome and distracting" (*Anderson et al* Col. 6, lines3-4). This highlights that the general principle of operation in the *Anderson et al* device is to promote an alternative race viewing method with maintaining hands free convenience at the arena. By contrast, the present invention is repeatedly described as a device intended to be held in the hands. That is, the principle of operation for a handheld

device differs from that described in *Anderson et al* because the reference is specific in explaining it is primarily designed to provide hands free convenience. This is a clear indication that the two inventions do not share the same basic principle of operation.

Finally, on a more fundamental level, the basic principle underlying the two inventions is different because the underlying advantage in using a handheld and head mounted device are different. The primary inventive idea behind the head mounted display described in *Anderson et al* is to provide sports viewers a convenient alternative mechanism for viewing an event. It should be noted the head mounted display described is a relatively uncommon item, not likely to be owned by a general member of the public. The specification in *Anderson et al* recognizes as much stating "the user attends the race and is provided a receiver for his individual use" (*Anderson et al* Col. 6, lines 5-7). Thus, the idea behind the *Anderson* invention is to provide patrons a head mounted display at a sporting event thereby providing a convenient, hands free mechanism for viewing the event. This invention allows a patron to attend a sporting function without concerning themselves with acquiring any extra equipment for viewing the event. The head mounted display is provided to the patron at the event. The patron can then wear the apparatus on their head while maintaining the convenience of the continued use of their hands.

By contrast, the primary inventive idea of the presently described handheld device is not to provide event patrons with an apparatus which allows them the convenient use of their hands. The handheld device is fundamentally a sacrifice of the convenience described in *Anderson et al* for the newly conceived convenience of using a device already owned by the patron. This explains how the primary purpose of the present invention differs from that of the *Anderson et al* reference.

This point is specifically not addressed in the Board's analysis. For example, the Board notes the present specification describes handheld devices as including Personal Digital Assistants, handheld televisions, data-enabled wireless telephones, and cellular telephones. This underscores the fact that the present invention is broadly composed of a viewing device the patron is expected to already own and bring to the venue. Thus, the basic principal of operation of the present invention is

to afford users the convenience of enhanced venue viewing with an item they already possess. As such, the interpretation of the *Anderson et al* head mounted display as a handheld device represents an improper change to the basic principle of the reference's operation.

Although Applicants argued that *Anderson et al* does not teach, nor can it reasonably expect to achieve with its head mounted display form factor, the real-time, *simultaneous* viewing of video captured from more than one camera at an entertainment venue, Applicants' point was perhaps not made clear enough to overcome this very clear limitation in *Anderson et al*. Despite their challenge on appeal, Applicants' have decided, without agreeing with the Board on matters previously presented, that the best course of action is to reopen prosecution under 37 CFR 1.198 by filing and RCE under 37 CFR 1.114 and provide amendments to their claims as their submission.

Although applicants continue to disagree that *Anderson et al* combined with *Jain* taught their invention as previously claimed, the current amendment of record should now make it much clearer to the Examiner where the nonobvious distinctions lay between Applicants' invention and the prior art of record.

The invention claimed in remaining independent claims 1, 18, 19, 20, 35, 41 and 45 provides methods and systems that are believed to overcome the 35 U.S.C. 103 rejections of record.

The invention as shown through claimed elements in each of the above claims is explicitly described in the specification as indicated and enables the capturing of video images from more than one perspective of a venue-based activity using more than one video camera and processing of the video images into venue-based data formatted for wireless transmission via wireless communications systems and methods not taught by the art of record for display at the venue by more than one hand held devices also not taught by the art of record.

Applicants therefore respectfully traverse the rejections of their remaining, amended claims and respectfully request their issuance.

III. CONCLUSION

The amended claims of the present invention are not obvious based on the combination of *Anderson et al* and *Jain et al*. Combining these references fails to teach or yield the invention as now claimed. The combination of *Anderson et al* and *Jain et al* with either *Ausems* and/or *Blanchard* also fails to teach or suggest all the elements of the newly amended claims.

Applicants respectfully request that the amended claims now of record be allowed and that their application be processed for prompt issuance.

Respectfully submitted,

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